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SUPREME COURT

# In the Supreme Court of the United States

No. 73-1342

SILVESTRI CORPORATION,
*Petitioner,*

vs.

MARSHALL FIELD & CO., J. C. PENNEY CO., INC. and CO-OP ELECTRIC SUPPLY CO.,
*Respondents.*

## RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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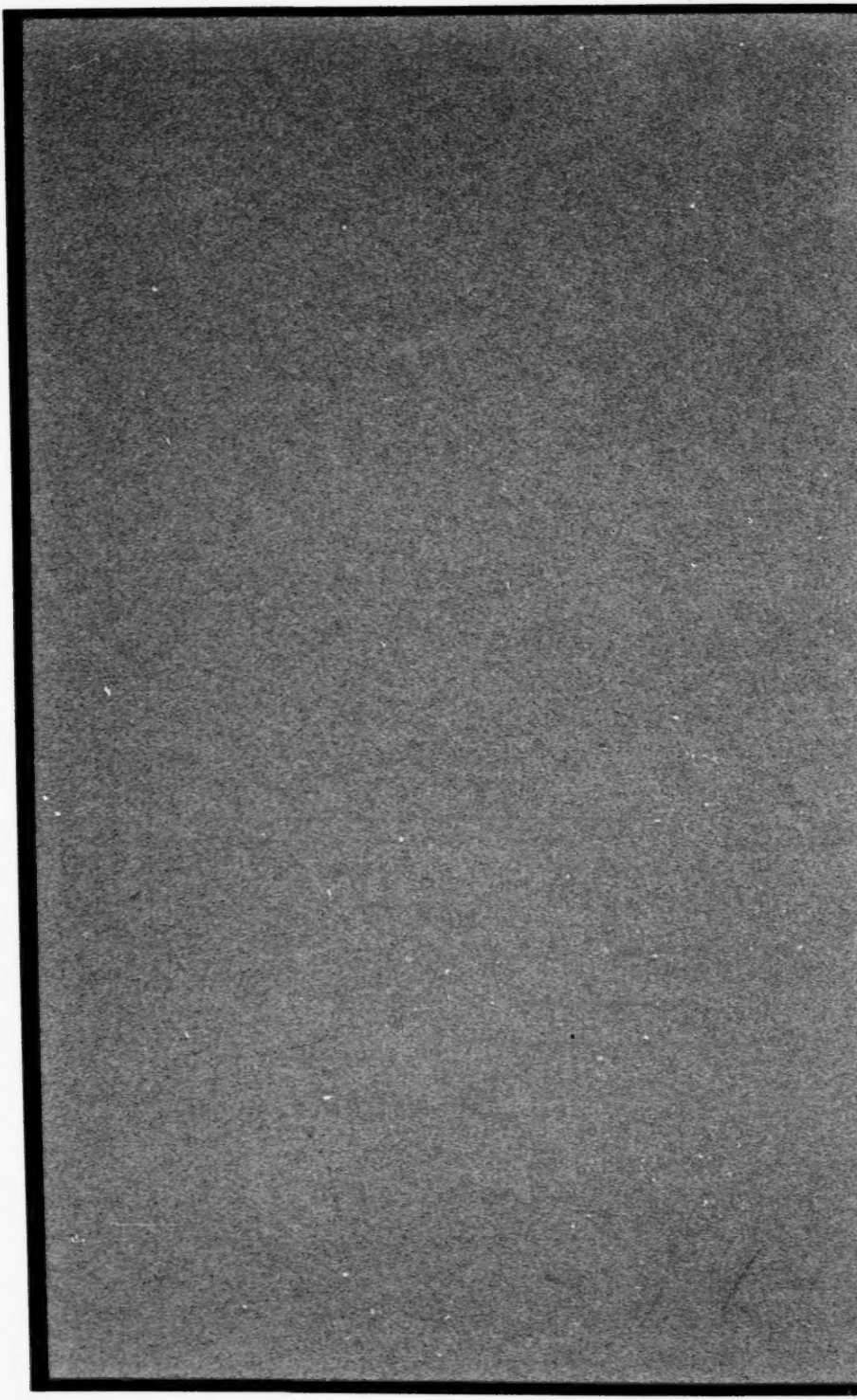

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## RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

Respondents oppose the grant of writ of certiorari in this case.

## REASONS FOR OPPOSITION

1. Question 1 as presented by petitioner is a contrived question which improperly interprets the language and decisional processes of the District Court and the Court of Appeals. Both Courts meticulously followed and applied the *Graham* v. *Deere* guidelines established by this Court[1]

1. 383 U.S. 1, 17; 86 S.Ct. 684, 694

for use in arriving at a proper application of Section 103 of Title 35, United States Code. There is no indication that either of the lower Courts refused to, or did not in fact, take into account any of the pertinent questions to be resolved. Indeed, the record is quite otherwise. The filling of a long felt need and consequent alleged commercial success of the patented invention was relied on heavily in petitioner's presentation in the Courts below; in both instances the evidence was reviewed and found wanting (A. 13, Finding 27; A. 2; A. 5).

2. *Graham* v. *Deere* does not require in every case a detailed analysis and specific findings as to one or more of the "secondary considerations". The Court suggested only that such "might be utilized"[2] where needed to resolve the primary questions of scope and content of the prior art; differences between the patented subject matter and the prior art; and level of skill in the art. See also *Anderson's Black Rock, Inc.* v. *Pavement Salvage Co., Inc.*, 396 U.S. 57; 90 S. Ct. 305 (1969). Here the lower Courts had no difficulty in applying the art or in determining the level of skill.

3. Evidence as to the "secondary considerations" was in fact received and made a part of the record in the District Court. Moreover, the feature of "commercial success" was dealt with specifically by the District Court (Finding 27, A. 13) and by the Court of Appeals (A. 5).

4. Question 2 as presented by petitioner goes to the scope of coverage to be given the claims of the patent. The conclusion of both of the Courts below, that the equipment sold by respondents was not covered by the claims,

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2. 383 U.S. 1, 17; 82 S.Ct. 684, 694

was reached not only on the basis of the clear disclosure of the patent, but also on the pertinent provisions of the Patent Statutes, prior decisions of this Court and certain factual considerations delineated by the District Court (A. 14, 15) and Court of Appeals (A. 5, 6). There is no conflict with the Fifth Circuit. The Court of Appeals in this case did not base its affirmance of the District Court upon the fact that the patent disclosed a single brace. As the Court said:

> "The plaintiff's patent specification describes a single adjustable brace rod on the exterior and the flat surface of the housing on the inside of the tub. There is no disclosure of the defendants' movable, flexible, adjustable plate in the accused device, which is on the inside of the tub, to cooperate with the adjustable slide members on the outside, to clamp the device onto the tub. Mr. Kellogg, whose testimony the Trial Judge obviously credited, testified that different weight transfers take place in the accused device to provide as little pressure on top as possible to accommodate aluminum rails." (A. 6).

Obviously, it was factors other than the "single brace" versus "two slide members" that compelled the finding of non-infringement.

5. The Courts below did apply the equitable doctrine of equivalents stated by this Court in its prior decisions and adopted and embodied in Section 112 of Title 35, United States Code. That this petitioner disagrees with the findings of fact made in considering the doctrine does not establish that an incorrect principle of law was applied.

## CONCLUSION

The petition is based entirely on factual arguments specific to the case. There are no novel legal questions nor is there any conflict between Courts of different Circuits on any legal issue. The petition is based on no consideration warranting the granting of writ of certiorari and should be denied (Rule 19, Rules of the United States Supreme Court).

Respectfully submitted,

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